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**UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION**

OSCAR TUBIO,

Plaintiff,

v.

ADIDAS AMERICA, INC., AN
OREGON CORPORATION; ADIDAS
AG, A GERMAN STOCK
CORPORATION; AND DOES 1
THROUGH 500, INCLUSIVE,

Defendants.

Case No. 2:22-cv-06424-GW (PVCx)
Judge: *Hon. George H. Wu*

**DEFENDANT ADIDAS AMERICA,
INC.'S MEMORANDUM OF
POINTS AND AUTHORITIES IN
SUPPORT OF ITS MOTION TO
DISMISS AND FOR FEES**

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Pursuant to Federal Rule of Civil Procedure 12(b)(6), Defendant adidas America, Inc. (“adidas”) submits this memorandum in support of its motion to dismiss the Complaint of Plaintiff Oscar Tubio (“Plaintiff” or “Mr. Tubio”).¹

I. INTRODUCTION

Copyright law protects “*original* works of authorship.” 17 U.S.C. § 102(a) (emphasis added). Supreme Court authority confirms that originality is the *sine qua non* of copyright, and explains that “originality” presupposes “at least some minimal degree of creativity.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) (denying copyright protection to alphabetical telephone directory). Courts have found repeatedly that when a work lacks creativity, it is incapable of protection under the U.S. Copyright Act.

In this case, Plaintiff asserts copyright rights in a basic graphic – a logo for the Argentine soccer team Boca Juniors - consisting of uncopyrightable preexisting elements (the “CABJ Graphic,” shown below):



Docket No. 2-2. Plaintiff cannot exploit United States copyright law to protect the CABJ Graphic. As noted above, the Copyright Act does not protect *all* pictorial designs, no matter how simplistic or banal. Instead, the Copyright Act requires a work to include a meaningful quotient of “originality,” which means (1) independent creation by the author and (2) creativity. The CABJ Graphic does not clear this modest threshold. The letters “CABJ” are not copyrightable (and, in any event, did not originate with Mr. Tubio.) The blue/yellow color scheme is not copyrightable (and also did not originate with Mr. Tubio.) The typography of the letters is not copyrightable (and was not created by Mr. Tubio.) And, the eight-

¹ Named Defendant adidas AG has not yet been served in this action and is not a party to this motion.

1 pointed star simply comprises the overlay of two geometric shapes and is a common
 2 ancient religious symbol ... and not original to Mr. Tubio. Plaintiff merely has taken
 3 uncopyrightable pre-existing elements and assembled them in an obvious, linear
 4 fashion. Lastly, the trivial *combination* of these uncopyrightable elements cannot be
 5 subject to copyright, as both federal courts and the Copyright Review Board have
 6 routinely held.

7 For these reasons, and as explained in more detail below, Plaintiff's
 8 Complaint should be dismissed with prejudice, and the Court should award adidas
 9 its fees incurred in defending this objectively meritless claim. The Copyright Act
 10 simply does not offer protection for this kind of design, and dismissals implicating
 11 the core concerns of the Copyright Act call for the award of fees.

12 **II. STANDARD FOR MOTION TO DISMISS**

13 Under Federal Rule of Civil Procedure 12(b)(6), "[a] complaint may be
 14 dismissed for failure to state a claim for one of two reasons: (1) lack of a cognizable
 15 legal theory; or (2) insufficient facts under a cognizable legal theory." *Ciero v. Walt*
 16 *Disney Co.*, No. CV 17-8544-GW (MRWx), 2018 WL 11352373, at *2 (C.D. Cal.
 17 May 21, 2018) (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)); *see*
 18 *also Mendiondo v. Ceintinela Hosp. Med. Ctr.*, 521 F.3d 1097, 1104 (9th Cir. 2008)
 19 (noting dismissal is appropriate when "the complaint lacks a cognizable legal theory
 20 or sufficient facts to support a cognizable legal theory"). A complaint must contain
 21 enough facts to establish a "plausible" entitlement to relief that is more than merely
 22 speculative. *Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009). But even when a complaint
 23 contains plausible factual allegations, the Court must "determine whether [the
 24 allegations] plausibly give rise to an entitlement to relief." *Id.* at 664. In other words,
 25 dismissal is appropriate when a "[plaintiff] can prove no set of facts in support of
 26 [its] claims which would entitle [it] to relief." *City of Almaty v. Khrapunov*, 956
 27 F.3d 1129, 1131 (9th Cir. 2020) (alterations in original)(citation omitted).

1 **III. PLAINTIFF’S COPYRIGHT CLAIM SHOULD BE DISMISSED WITH**
 2 **PREJUDICE FOR LACK OF ORIGINALITY**

3 To prevail on a claim for copyright infringement, Plaintiff must establish “(1)
 4 ownership of a valid copyright and (2) copying of constituent elements of the work
 5 that are original.” *Feist*, 499 U.S. at 361. In keeping with copyright’s Constitutional
 6 objective of promoting “the Progress of Science and useful Arts,” U.S. Const., art. I
 7 § 8, cl. 8, the originality requirement is fundamental to establishing copyright
 8 validity, because only “*original* works of authorship fixed in any tangible medium
 9 of expression” are entitled to the benefits of copyright protection. 17 U.S.C. §
 10 102(a) (emphasis added). *See Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003)
 11 (quoting 17 U.S.C § 102(a)). For a work to be original, it must (1) be
 12 “independently created by the author (as opposed to copied from other works)” and
 13 (2) possess “at least some minimal degree of creativity.” *Feist*, 499 U.S. at 345.
 14 (*Satava*, in reciting this standard, notes that the work must include more than
 15 “negligible” creativity. *Satava*, 323 F.3d at 810.) “The protectability of elements of
 16 a copyrighted work is a question of law for the court.” *Newton v. Diamond*, 204 F.
 17 Supp. 2d 1244, 1253 (C.D. Cal. 2002), *aff’d*, 349 F.3d 591 (9th Cir. 2003), *opinion*
 18 *amended and superseded on denial of reh’g*, 388 F.3d 1189 (9th Cir. 2004),
 19 *and aff’d*, 388 F.3d 1189 (9th Cir. 2004).

20 Plaintiff’s copyright claim fails here because the CABJ Graphic is
 21 insufficiently creative to merit copyright protection. Its component parts are wholly
 22 unoriginal to Mr. Tubio, and the assembly of those component parts is so trivial that
 23 it fails to imbue the work with the degree of creativity required to be protectable.
 24 Notably, Plaintiff asserts no registration of the CABJ Graphic with the United States
 25 Copyright Office, and, for the reasons explained below, adidas submits that Plaintiff
 26 indeed would be unable to obtain U.S. registration for his graphic. Under the
 27 Copyright Act, “no civil action for infringement of the copyright in any *United*
 28 *States work* shall be instituted until ... registration of the copyright claim has been

made.” 17 U.S.C. § 411(a) (emphasis added). Owners of foreign works like the one at issue here, however, may sue in the United States without a registration.

Plaintiff’s complaint references an Argentina copyright registration, but that claimed Argentine copyright is immaterial here. If the CABJ Graphic is insufficiently original under U.S. copyright law, Plaintiff cannot state a copyright-infringement claim in a U.S. court. *See Fahmy v. Jay-Z*, 908 F.3d 383, 391 (9th Cir. 2018) (noting the “[Berne] Convention guarantees only that holders of foreign copyrights are afforded ‘the same protection’ as holders of domestic copyrights”) (citation omitted) (denying application of Egyptian moral rights to U.S. copyright dispute). Accordingly, Plaintiff’s copyright claim must be dismissed.

A. The CABJ Graphic Lacks the Creativity Necessary for Copyright Protection

The CABJ Graphic lacks sufficient creativity to merit copyright protection. That a work was independently created is not sufficient for copyright protection to attach—a work must also clear a minimum threshold level of creativity. *See Skidmore v. Led Zeppelin*, 952 F.3d 1051, 1071 (9th Cir. 2020) (“[O]riginality requires at least ‘minimal’ or ‘slight’ creativity—a ‘modicum’ of ‘creative spark’—in addition to independent creation.”)(citation omitted). Plaintiff’s asserted graphic fails this test.

The component elements of the CABJ Graphic are unprotectable (and, indeed, were not even independently created by Mr. Tubio). First, the letters CABJ merely constitute an unprotectable acronym, one commonly used to refer to the Boca Juniors team. Second, the blue/yellow color scheme is simply a basic and common color combination, and, like the letters CABJ, have served to identify the Boca Juniors team for decades. Third, the typeface used within the design is not subject to copyright protection, and, like the letters and color scheme, predated Mr. Tubio’s design. Fourth, the eight-sided star results from the simple overlay of two “square” shapes atop one another, and, beyond that, is a common historical symbol;

1 relevant authority makes clear that this is not copyrightable. Lastly, even when
 2 these elements are combined, Plaintiff's creative contribution is insufficient for
 3 copyright protection.

4 **1. The Letters C-A-B-J Are an Unprotectable Acronym**

5 The letters C-A-B-J that appear in the CABJ Graphic are not protectable
 6 under the law of copyright, which prohibits copyright protection in "words and short
 7 phrases." *See* Rules of the Copyright Office, 37 C.F.R. § 202.1 (including among
 8 "examples of works not subject to copyright" "[w]ords and short phrases such as
 9 names, titles, and slogans"). Courts in the Ninth Circuit have applied this rule in an
 10 array of decisions. *See Apps v. Universal Music Grp.*, 763 F. App'x 599, 600 (9th
 11 Cir. 2019) (refusing protection to phrase "I need to know now"); *Planesi v. Peters*,
 12 No. 04-16936, 2005 WL 1939885, at *1 (9th Cir. Aug. 15, 2005) (affirming
 13 dismissal of copyright-infringement claim based on "one word name of [Plaintiff's]
 14 board game"); *Sega Enter. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1524 n.7 (9th Cir.
 15 1992) (noting "20 bytes of initialization code plus the letters S-E-G-A . . . is of such
 16 de minimis length that it is probably unprotected under the words and short phrases
 17 doctrine"). Other courts have followed this rule in refusing to recognize copyright
 18 protection in words and short phrases. *See, e.g., McDonald v. West*, 138 F. Supp. 3d
 19 448, 454 (S.D.N.Y. 2015) (holding "short phrases, including titles and slogans,
 20 rarely if ever exhibit sufficient originality to warrant copyright protection"); *Trenton*
 21 *v. Infinity Broad. Corp.*, 865 F. Supp. 1416, 1426–27 (C.D. Cal. 1994) (denying
 22 copyright protection to word "Loveline," the title of a radio show).

23 Regardless, the letters C-A-B-J were not independently created by Plaintiff.
 24 They have served for decades as a commonly-used abbreviation for Club Atlético
 25 Boca Juniors, a fact Plaintiff alleges in his Complaint. *See* Docket No. 2 ¶ 12
 26 (alleging that the team used the initials "CABJ" as part of a prior design); *see also*
 27 Historia, Club Atlético Boca Juniors, [https://www.bocajuniors.com.ar/el-](https://www.bocajuniors.com.ar/el-club/historia?lang=en)
 28 [club/historia?lang=en](https://www.bocajuniors.com.ar/el-club/historia?lang=en). Accordingly, the acronym affords the CABJ Graphic no

1 copyright protection.

2 **2. The Blue-and-Yellow Colors Are Not Copyrightable**

3 The blue-and-yellow coloration of the CABJ Graphic is not protectable and
 4 should be subtracted from the Court’s analysis of the graphic’s creativity. The
 5 Copyright Act and relevant authorities ordinarily prohibit copyright protection for
 6 colors standing alone. *See* 38 C.F.R. § 202.1(a) (listing among “works not subject to
 7 copyright . . . mere variations of . . . coloring”). The Ninth Circuit has held that
 8 “colors themselves are not generally copyrightable.” *Daniels v. Walt Disney Co.*,
 9 958 F.3d 767, 772 (9th Cir. 2020), *cert. denied*, 141 S.Ct. 1050 (2021); *see also*
 10 *Express, LLC v. Forever 21, Inc.*, No. CV 09–4514 ODW (VBKx), 2010 WL
 11 3489308, at *6 (C.D. Cal. Sept. 2, 2010) (citing U.S. Copyright Off., Compendium
 12 of U.S. Copyright Off. Practices § 503.02(a) (3d ed. 2021) for the proposition that
 13 “mere coloration cannot support a copyright even though it may enhance the
 14 aesthetic appeal or commercial value of a work”); *cf. Ets-Hokin v. Skyy Spirits, Inc.*,
 15 225 F.3d 1068, 1079–80 (9th Cir. 2000) (rejecting the argument that a vodka
 16 bottle’s “blue color, gold label, etc.” merit copyright protection; even if trade dress
 17 covered those colors, “that protection [wa]s irrelevant to deciding whether the bottle
 18 is a preexisting work under the Copyright Act”).

19 In any case, the colors of Plaintiff’s design—blue on a yellow field—are the
 20 colors of the Boca Juniors club. *See* Docket No. 2-1 (depicting Diego Maradona in
 21 blue-and-yellow Boca Juniors uniform); Boca Juniors, *Wikipedia* (October 25,
 22 2022), https://en.wikipedia.org/wiki/Boca_Juniors#Kit_and_badge. Thus, Plaintiff
 23 did not independently create the blue-and-yellow color scheme and may not avail
 24 himself of copyright protection in it.

25 **3. The Typeface in the CABJ Graphic Is Not Copyrightable**

26 Plaintiff cannot obtain copyright protection in the CABJ Graphic by virtue of
 27 its typeface. The Ninth Circuit has observed in a published decision that “typefaces
 28 are not afforded copyright protection.” *Monotype Corp. PLC v. Int’l Typeface Corp.*,

43 F.3d 443, 446 (9th Cir. 1994); *see also* *Coach Servs., Inc. v. Cielo Creations, Inc.*, No. CV 10-4108 GAF (Ex), 2011 WL 13217091, at *11 (C.D. Cal. Aug. 16, 2011) (noting that “letters of the alphabet, along with their varying font designs, fall into the public domain”); *Yu Zhang v. Heineken N.V.*, No. CV 08-6506 GAF (RCx), 2010 WL 11596643, at *5 (C.D. Cal. Sept. 29, 2010) (holding calligraphy lacked “the minimal amount of originality” because “Chinese words, like English words, do not receive copyright protection simply because they are designed more ornately”). Congress excluded typefaces from the Copyright Act. *See* H.R. Rep. No. 94-1476 at 55-56 (1976) (“The Committee does not regard the design of typeface ... to be a copyrightable ‘pictorial, graphic, or sculptural work[.]’”); *see also* 37 C.F.R. § 202.1(a) (listing among “works not subject to copyright” “mere variations of typographic ornamentation, lettering or coloring”). Accordingly, the blue font inside the yellow stars in the CABJ Graphic cannot draw copyright protection.

In any case, the CABJ Graphic’s typeface was derived from a prior version of the Boca Juniors’ crest:



1970

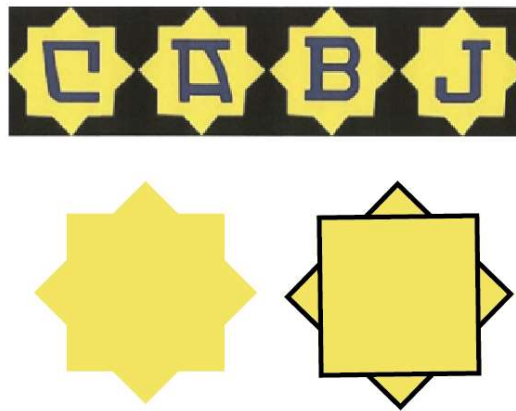
See El club–Badge, Club Atlético Boca Juniors, <https://www.bocajuniors.com.ar/el-club/escudo?lang=en>. Thus, Plaintiff did not independently create the typeface for the CABJ Design, which accordingly does not merit copyright protection.

4. The Common Geometric Shapes and Symbols in the CABJ Graphic Are Not Copyrightable

As with all the other component elements discussed above, the CABJ Graphic

1 cannot derive copyright protection by virtue of its use of eight-pointed yellow stars.
 2 In the first place, Plaintiff concedes in his Complaint that the Boca Juniors' club
 3 crest incorporated a star motif before he ever assembled the CABJ Graphic, so the
 4 CABJ Graphic's stars were not Plaintiff's independent creation. Complaint ¶ 12.

5 But regardless, copyright does not protect the ordinary geometric shapes that
 6 form the basis of the eight pointed star. A brief examination of this figure makes
 7 clear that it is simply the product of overlaying two simple squares atop one another,
 8 with one of the squares rotated at an angle:



17 As the U.S. Copyright Office's Compendium of Copyright Office Practices
 18 makes clear, "The Copyright Act does not protect common geometric shapes" .
 19 Compendium (Third) § 901.1.² Further, "[T]he Office cannot register a work
 20 consisting of a simple combination of a few familiar symbols or designs" *Id.* at
 21 § 313.4(J). The formation of a star figure by offsetting two ordinary squares cannot
 22 result in a copyrightable work.

23 _____
 24 ² The Copyright Compendium is a manual published by the U.S. Copyright
 25 Office that "provides instruction to agency staff regarding their duties and provides
 26 expert guidance to copyright applicants, practitioners, scholars, the courts, and
 27 members of the general public regarding institutional practices and related principles
 28 of law." Compendium (Third), intro. The Ninth Circuit has held the interpretations of
 the Copyright Act in the Compendium to be "reasonable and consistent" and
 therefore "entitled to deference." *Batjac Prods. Inc. v. GoodTimes Home Video
 Corp.*, 160 F.3d 1223, 1231 (9th Cir. 1998).

On these grounds, a judge in this district dismissed the case of a hookah-pipe designer; even though the pipe combined “two or three [] common geometric shapes . . . the components of the water container [we]re simply not works of art in even the broadest, most liberal sense.” *Inhale, Inc. v. Starbuzz Tobacco, Inc.*, No. 2:11-cv-3838-ODW (FFM), 2017 WL 4163990, at *3 (C.D. Cal. May 8, 2017) (“[D]espite Inhale’s flowery language describing the features, they [we]re essentially geometric shapes of the most common type.”). Out-of-circuit courts agree that grafting common geometric shapes onto one another does not earn copyright protection. *See Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 35 (1st Cir. 2001) (“This collection of common geometric shapes with a particular photographic technique is not sufficiently original to qualify for copyright protection.”); *see also Kelley v. Chi. Park Dist.*, 635 F.3d 290, 303 (7th Cir. 2011) (“It is true that common geometric shapes cannot be copyrighted.”); *William S. Geiger Corp. v. Gigi Accessories, Inc.*, 49 U.S.P.Q.2d 1218, 1219 (S.D.N.Y. Aug. 11, 1997) (holding “plaintiff has no right to copyright a rose or a common geometrical shape”).

Moreover, copyright does not protect “familiar religious symbols” and other “[w]ell-known and commonly used symbols that contain a *de minimis* amount of expression.” Compendium (Third) § 313.4(J). The eight-pointed star is a common symbol with roots in Hinduism, according to online sources. *See STANDS4 LLC*, star of Lakshmi, Definitions.net (Nov. 5, 2022) <https://www.definitions.net/definition/star+of+lakshmi> and Eric W. Weisstein, Star of Lakshmi, Mich. St. Univ. (May 26, 1999) <https://archive.lib.msu.edu/crcmath/math/math/s/s686.htm>. Even the briefest of Google Image searches on the term “eight pointed star” turns up a litany of figures highly similar to Plaintiff’s CABJ stars.³

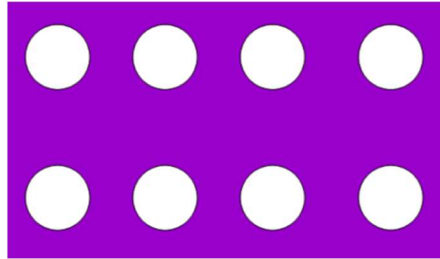
³ adidas requests the Court take judicial notice of the fact that eight-pointed stars are commonly used religious symbols as a fact “not subject to reasonable

1 In short, there is insufficient artistry in the star component of the CABJ
2 Graphic to merit protection.

3 **5. Neither Repeating Elements Nor Combining**
4 **Uncopyrightable Typeface and Uncopyrightable Shapes**
5 **Yields Copyright Protection**

6 Up to this point, this brief has examined the unprotectability of the individual
7 elements composing the CABJ Graphic. Plaintiff's final potential argument for
8 protectability here would be that he has created a copyrightable work by virtue of
9 his repetition of the "star" element and/or his combination of letters and shapes.
10 Multiple court decisions and Copyright Review Board holdings make clear that this
11 argument must fail.

12 To the extent Mr. Tubio asserts a copyright in the repetition of the stars, this
13 proposition is refuted by the Compendium; indeed, this mere repetition is – quite
14 literally – a textbook example of what is *not* protectable. The Copyright
15 Compendium addresses a closely analogous hypothetical and instructs that a similar
16 design to the CABJ Configuration would not be copyrightable:



22 The registration specialist will refuse to register this claim because
23

24 dispute” within the meaning of Fed. R. Evid. 201. *See L.A. Printex Indus., Inc. v.*
25 *Forever 21, Inc.*, No CV 09–3382 SVW (CWx), 2009 WL 10698834, at *6 (C.D.
26 Cal. Oct. 27, 2009) (taking judicial notice “that the anchor symbol has existed in the
27 public domain for some time” as a fact “generally known and is not subject to
28 reasonable dispute”). In the alternative, the Court may convert this motion to one for
summary judgment to consider the same fact. *Punchbowl, Inc. v. AJ Press LLC*, No.
2:21-CV-03010 SVW MAR, 2021 WL 6882373, at *1 (C.D. Cal. June 21, 2021).

1 simple geometric symbols are not eligible for copyright protection,
 2 and the combination of the purple rectangle and the standard
 3 symmetrical arrangement of the white circles does not contain a
 4 sufficient amount of creative expression to warrant registration.

5 Compendium (Third) § 906.1.

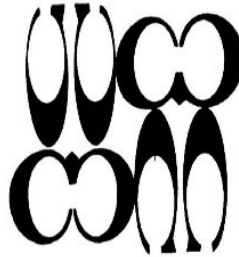
6 Moreover, the CABJ Graphic does not earn copyright protection by
 7 combining an unprotectable typeface with unprotectable geometric shapes. “[A]
 8 combination of unprotectable elements is eligible for copyright protection *only if*
 9 those elements are numerous enough and their selection and arrangement original
 10 enough that their combination constitutes an original work of authorship.” *Satava*,
 11 323 F.3d at 811 (emphasis added); *see also Lamps Plus, Inc. v. Seattle Lighting*
 12 *Fixture Co.*, 345 F.3d 1140, 1147 (9th Cir. 2003) (holding the “mechanical
 13 combination of four preexisting ceiling-lamp elements with a preexisting table-lamp
 14 base did not result in the expression of an original work of authorship as required by
 15 [the Copyright Act]”); *John Muller & Co. v. N.Y. Arrows Soccer Team, Inc.*, 802
 16 F.2d 989, 990 (8th Cir. 1986) (affirming Copyright Register’s refusal to register for
 17 lack of creativity a logo consisting of four angled lines forming an arrow with the
 18 word “Arrows” in cursive script below) (see below image):



24 APPENDIX A

25 Courts and the Copyright Review Board routinely refuse to recognize
 26 copyright protection in simplistic combinations of letters and shapes like Plaintiff’s
 27 CABJ Graphic. *See* Compendium (Third) § 905 (“In all cases, a visual art work
 28 must contain a sufficient amount of creative expression. Merely bringing together

only a few standard forms or shapes with minor linear or special variations does not satisfy this requirement.”). For example, in *Coach, Inc. v. Peters*, the Southern District of New York deferred to the decision of the Copyright Register that the “C” arrangement on Coach designer bags was insufficiently original to merit copyright protection:




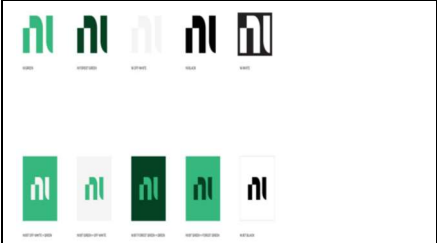
386 F. Supp. 2d 495, 498–99 (S.D.N.Y. 2005) (agreeing that “the elements embodied in this work, individually, *and in their particular combination and arrangement*, simply do not contain sufficient amount of original and creative authorship to be copyrightable”) (alteration in original) (citations omitted). Citing *Coach*, the Eastern District of New York held that “the combination of unprotectable elements in ... cod liver packaging is not eligible for copyright protection”:





Threeline Imports, Inc. v. Vernikov, No. 15 Civ. 2333 (AMD) (RML), 2016 WL 11472749, at *13 (E.D.N.Y. Oct. 28, 2016) (granting motion for summary judgment to dismiss claim based on this design); *see also Aldar Tobacco Grp., LLC v. Am. Cigarette Co.*, No. 08-62018-CIV-JORDAN, 2010 WL 11549585, at *3 (S.D. Fla.

1 Mar. 24, 2010) (rejecting effort to enforce cigarette box design incorporating
2 stylized V in part because “‘mere variations of typographic ornamentation, lettering,
3 or coloring’ are not subject to copyright” (quoting 37 C.F.R. § 202.1)).

4 Likewise, the Copyright Review Board has rejected a host of applications to
5 register simplistic letter-and-shape designs on the grounds that those designs were
6 insufficiently original to merit copyright protection. The Copyright Review Board is
7 an administrative tribunal, operating under the auspices of the Copyright Office, that
8 hears appeals from denials of copyright registration. The Ninth Circuit and its
9 district courts have often deferred to the Copyright Office’s determinations and used
10 its decisions for guidance. *See Garcia v. Google, Inc.*, 786 F.3d 733, 741–42 (9th
11 Cir. 2015) (“The Copyright Office’s well-reasoned position ‘reflects a body of
12 experience and informed judgment to which courts and litigants may properly resort
13 for guidance.’”) (citations omitted); *Marascalco v. Fantasy, Inc.*, 953 F.2d 469, 473
14 (9th Cir. 1991) (“We agree with the D.C. Circuit that the Register has the authority
15 to interpret the copyright laws and that its interpretations are entitled to judicial
16 deference if reasonable.”) (citing *Cablevision Sys. Dev. Co. v. Motion Picture Ass’n*
17 *of Am., Inc.*, 836 F.2d 599, 607–10 (D.C. Cir. 1988)); *Media.net Advert. FZ-LLC v.*
18 *NetSeer, Inc.*, 156 F. Supp. 3d 1052, 1061 (N.D. Cal. 2016) (holding the court may
19 “adopt[] the Copyright Office’s interpretations of copyright law where it finds them
20 reasonable and persuasive”). The Board has often rejected as inadequately creative
21 designs highly similar to Plaintiff’s:
22
23
24
25
26
27
28

| Design | Citation | Grounds |
|---|---|---|
|  | <p>Letter from U.S. Copyright Off. Review Bd. to Tracy-Gene G. Durkin at 4 (Correspondence ID 1-4570GV3; SR # 1-7440489181) (Dec. 28, 2021) https://copyright.gov/rulings-filings/review-board/docs/words-with-friends-2-tiles.pdf (regarding Second Request for Reconsideration for Refusal to Register Words With Friends 2 Tiles)</p> | <p>“[T]he ‘W’ and number four constitute mere lettering, which is unprotectable, and the reflective element is a standard design element. Their combination does not elevate the Argyle Tiles above the threshold for creativity because this is a stock arrangement relatively typical for game tiles. Additionally, argyle patterns are a common design motif, originating with a Scottish clan tartan dating back to at least the 17th century. . . . And because each tile overlays a single color on its argyle pattern and the letter and number on the tile, the coloring of each tile amounts to ‘[m]erely adding or changing’ one color in the work.” (footnote omitted) (citation omitted).</p> |
|  | <p>Letter from U.S. Copyright Off. Review Bd. to</p> | <p>“[T]he letters are arranged in two lines of five logos per line, which constitutes a ‘mere</p> |

| Design | Citation | Grounds |
|---|---|--|
| | <p>John C. Cain at 4-5</p> <p>(Correspondence ID 1-4NN6VPM; SR# 1-8968610561)</p> <p>(Apr. 11, 2022)</p> <p>https://www.copyright.gov/rulings-filings/review-board/docs/2019-ni-logo-variants.pdf</p> <p>(regarding Second Request for Reconsideration for Refusal to Register 2019 NI Logo Variants)</p> | <p>simplistic arrangement’ that evidences insufficient creativity.</p> <p>The combination and arrangement in the Work are too standard to constitute an original work of authorship. The addition of a square or rectangle surrounding the letters in each bottom square of the grid as well as the top right square of the grid does not alter the fact that the combination and arrangement of these elements are ‘commonplace.’” (internal citations and citations omitted)</p> |
|  | <p>Letter from U.S. Copyright Off. Review Bd. to Charles J. Meyer at 6</p> <p>(Correspondence</p> | <p>“Looking at each Work as a whole, only two solid colors are used, and there is no shading or gradient use of the colors.</p> <p>Although the purple band within the yellow circle is stylized and</p> |

| Design | Citation | Grounds |
|---|---|---|
| | <p>ID 1-1-3L2KEJI; SR# 1- 7012397067, 7012396641, 7012468241) (June 25, 2020)⁴ https://www.copyright.gov/rulings-filings/review-board/docs/speedway-motors.pdf (regarding Second Request for Reconsideration for Refusal to Register S Logo)</p> | <p>has different widths, it is still essentially a circle band within a larger circle that follows the outline of the larger circle. Placing a business name on top of a geometric shape is a ‘garden-variety’ logo configuration that is not entitled to copyright protection.” (citation omitted)</p> |
|  | <p>Letter from U.S. Copyright Off. Review Bd. to ADT Sec. Servs. at 4 (Correspondence ID 1-LYOBLS)</p> | <p>“[V]iewed as a whole, the selection, coordination, and arrangement of the shapes, colors and letters that comprise the Work are not sufficient to render the Work original. The Work consists of little more than</p> |

⁴ This ruling was upheld by the District of Nebraska in *Speedway Motors, Inc. v. Perlmutter*, 553 F. Supp.3d 703 (D. Neb. 2021) (granting Register of Copyrights’ motion for summary judgment on originality issue).

| Design | Citation | Grounds |
|--------|---|--|
| | (Apr. 21, 2016) https://copyright.gov/rulings- filings/review- board/docs/octagon- n-adt- monogram.pdf (regarding Second Request for Reconsideration for Refusal to Register Octagon with ADT Monogram) | an ordinary blue octagon with a white border and a rectangle containing the letters ‘ADT’ printed at its center.” |

There are many more such examples. *See* Appendix A, attached hereto (listing additional recent Copyright Review Board decisions rejecting applications to register letter-and-shape designs like the CABJ Graphic). Put simply, the Copyright Review Board routinely rejects applications to register simplistic shape-and-letter combinations for lack of originality.

The CABJ Graphic is no different. It is, in fact, *less* creative than many of the designs that federal courts and the Copyright Review Board have refused to grant copyright protection for lack of originality. Plaintiff simply stamped blue letters on a yellow shape four times. Even the fourfold repetition of the stars was driven by necessity; there are *four* letters in the abbreviated form of the Boca Juniors’ name.

In sum, the CABJ Graphic merits no copyright protection by the simple

1 combination of unprotectable elements. Each component of the CABJ Graphic is
 2 either lifted from the Boca Juniors' team heraldry, and therefore unoriginal, or
 3 unprotectable as a matter of copyright law. And the design merely combines
 4 unprotectable elements in a trivial way.

5 Plaintiff's Complaint should be dismissed with prejudice because he can add
 6 no facts to salvage his claim. The CABJ Graphic is not sufficiently original to draw
 7 protection from the Copyright Act, and no new facts could change that. *See Pretty*
 8 *in Plastic, Inc. v. Bunn*, 793 F. App'x 593, 594 (9th Cir. 2020) (affirming this
 9 Court's dismissal of plaintiff's copyright infringement claim, *inter alia*, on grounds
 10 that its alleged unicorn depiction did not contain "the quantum of originality needed
 11 to merit copyright protection."). This Court has observed that copyright cases are
 12 ripe for dismissal in similar circumstances. *See* Final Ruling on Defendants
 13 Alexander Wang Incorporated and Alexander Wang's Motion to Dismiss Plaintiff's
 14 Corrected First Amended Complaint for Failure to State a Claim at 1-2, *Jangle*
 15 *Vision LLC v. Alexander Wang Inc.*, No. CV 21-9964-GW-Ex (C.D. Cal. June 3,
 16 2022), ECF No. 43 (holding that "a motion to dismiss a copyright infringement
 17 claim pursuant to Fed. R. Civ. P. 12(b)(6) can be entertained and, in the appropriate
 18 situation, granted" and dismissing copyright claim at the motion-to-dismiss stage);
 19 *DuMond v. Reilly*, No. CV 19-8922-GW-AGRx, 2021 WL 733311, at *5 (C.D. Cal.
 20 Jan. 14, 2021), ECF No. 41 (dismissing copyright claim at the motion-to-dismiss
 21 stage: "[i]n short, there is no question that Rule 12(b)(6)-based dismissals of
 22 copyright infringement claims may be had in the appropriate circumstances"),
 23 *appeal dismissed*, No. 21-55156, 2021 WL 3730226 (9th Cir. June 25, 2021); *see*
 24 *also* Nimmer on Copyright § 12.10[B][2] (noting that "authority . . . supports the
 25 view that to the extent that the defendant challenges the *quantum* of plaintiff's
 26 originality or creativity as a matter of law . . . these matters should be resolved
 27 solely by the judge").
 28

1 **B. Plaintiff’s Secondary-Liability Copyright Claim Fails With the**
 2 **Underlying Claim**

3 Plaintiff pleads secondary-liability copyright theories in Count II of his
 4 Complaint. Docket No. 2 ¶¶ 30–36. These fail with the underlying claim for lack of
 5 an original work that merits copyright protection. *A & M Records, Inc. v. Napster,*
 6 *Inc.*, 239 F.3d 1004, 1019-22 (9th Cir. 2001) (holding that vicarious copyright
 7 infringement and contributory copyright infringement claims require direct
 8 copyright infringement); *Carrel v. Origami Owl, LLC*, No. 18 Civ. 694 (NRB),
 9 2019 WL 1330941, at *4 (S.D.N.Y. Mar. 25, 2019) (holding when “claim for
 10 copyright infringement fails, [plaintiff’s] proposed claim for contributory
 11 infringement would necessarily fail as well”). Accordingly, if the Court dismisses
 12 Plaintiff’s underlying copyright claim (Count I), it should dismiss his secondary-
 13 liability claim as well (Count II).

14 **IV. THE COURT SHOULD AWARD ADIDAS FEES INCURRED**
 15 **DEFENDING A MERITLESS CLAIM**

16 The Court should award adidas its costs and attorneys’ fees under the
 17 Copyright Act for bringing this motion. *See* 17 U.S.C. § 505 (“[T]he court in its
 18 discretion may allow the recovery of full costs . . . , [and] the court may also award a
 19 reasonable attorney’s fee to the prevailing party as part of the costs.”). “The
 20 touchstone of the decision to award attorneys’ fees is whether the successful
 21 defense, and the circumstances surrounding it, further the Copyright Act’s ‘essential
 22 goals.’” *Tresóna Multimedia, LLC v. Burbank High School Vocal Music Ass’n*, 953
 23 F.3d 638, 652–53 (9th Cir. 2020) (citation omitted) (awarding fees to prevailing
 24 defendants). To determine whether fees are appropriate, courts “may consider . . .
 25 five factors”: “(1) the degree of success obtained, (2) frivolousness, (3) motivation,
 26 (4) [objective] reasonableness of [the] losing party’s legal and factual arguments,
 27 and (5) the need to advance considerations of compensation and deterrence.” *Id.* at
 28 653 (alterations in original) (citing *Wall Data Inc. v. L.A. Cty. Sheriff’s Dep’t*, 447

1 F.3d 769, 787 (9th Cir. 2006)). “Substantial weight should be accorded to the fourth
 2 factor.” *Id.* “A successful defense furthers the purposes of the Copyright Act just as
 3 much as a successful infringement suit does.” *Inhale, Inc. v. Starbuzz Tobacco, Inc.*,
 4 755 F.3d 1038, 1043 (9th Cir. 2014); *see also Gable v. Nat’l Broad. Co.*, No. CV
 5 08-0413 SVW (FFMX), 2010 WL 11506430, at *5 (C.D. Cal. Aug. 6, 2010) (“A fee
 6 award also helps to prevent the filing of similarly meritless copyright actions by
 7 would-be plaintiffs who may hope to extract a quick settlement from successful
 8 authors and producers through the threat of protracted litigation.”). Courts have
 9 accordingly held that in copyright cases “[t]he grant of fees and costs is the rule
 10 rather than the exception and [they] should be awarded routinely.” *Bridgeport*
 11 *Music, Inc. v. WB Music Corp.*, 520 F.3d 588, 592 (6th Cir. 2008) (second alteration
 12 in original) (citation omitted).

13 Here, awarding adidas costs and fees would vindicate an “essential goal” of
 14 the Copyright Act: the requirement that a work be sufficiently original for copyright
 15 protection. *See* 17 U.S.C. § 102(a); *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 524
 16 (1994) (“The primary objective of the Copyright Act is to encourage the production
 17 of *original* literary, artistic, and musical expression for the good of the public.”)
 18 (emphasis added)); *Mattel, Inc. v. MGA Entm’t, Inc.*, 705 F.3d 1108, 1111 (9th Cir.
 19 2013) (noting that the objectives of the Copyright Act are “furthered when
 20 defendants advance a variety of meritorious copyright defenses”) (citation omitted).
 21 “Because copyright law ultimately serves the purpose of enriching the general
 22 public through access to creative works, it is peculiarly important that the
 23 boundaries of copyright law be demarcated as clearly as possible.” *Fogerty*, 510
 24 U.S. at 527; *see also Gonzales v. Transfer Techs., Inc.*, 301 F.3d 608, 609 (7th Cir.
 25 2002) (Posner, J.) (“[A] successful defense enlarges the public domain, an important
 26 resource for creators of expressive works.”).

27 A fee award is particularly appropriate here because Plaintiff’s claim is
 28 objectively unreasonable based on the black-letter lack of copyright protection for

1 words, typefaces, and common geometric shapes, and the simplistic combination
 2 thereof. *Monotype Corp.*, 43 F.3d at 446; *Inhale, Inc.*, 2017 WL 4163990, at *3.
 3 Further, Plaintiff’s effort to copyright the design elements of prior Boca Juniors
 4 works subverts the “objective” of “encourag[ing] the production of *original* . . .
 5 expression.” *Fogerty*, 510 U.S. at 524 (emphasis added); *Gable*, 2010 WL
 6 11506430, at *5 (emphasis added) (awarding fees when a plaintiff’s claim was
 7 contrary to “well-settled copyright principles”).

8 Dismissal of Plaintiff’s copyright claim would be a “complete success” on
 9 that claim for adidas. *See Shame On You Prods., Inc. v. Banks*, 893 F.3d 661, 667
 10 (9th Cir. 2018) (holding that dismissal was a complete success for the defendant and
 11 noting that “‘successful defense of the action furthers the purposes of the Copyright
 12 Act’”) (quoting *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1120 (9th Cir.
 13 2007)). And dismissal would help to deter other objectively meritless copyright
 14 cases like this one. *See Scott v. Meyer*, No. CV 09–6076 ODW (RZx), 2010 WL
 15 2569286, at *3 (C.D. Cal. June 21, 2010) (“Deterring non-meritorious lawsuits
 16 against defendants seen as having ‘deep pockets’ and compensating parties that
 17 must defend themselves against meritless claims are both laudable ends.”).

18 The Court should, accordingly, award adidas its costs and fees. Under Rule
 19 54(d)(2)(C), adidas requests that the Court first decide Plaintiff’s liability for fees,
 20 then receive adidas’s “submissions on the value of services.” *Id.*

21 **V. CONCLUSION**

22 For the foregoing reasons, adidas respectfully requests that the Court dismiss
 23 with prejudice Plaintiff Oscar Tubio’s Complaint in its entirety and award adidas its
 24 attorneys’ fees incurred in drafting this Motion, a Reply, and attending a hearing.

1 DATED: November 7, 2022 Respectfully submitted,
2 KILPATRICK TOWNSEND & STOCKTON LLP
3 By: /s/Kollin J. Zimmermann
4 KOLLIN J. ZIMMERMANN
5 R. CHARLES HENN, JR. (*pro hac vice*)
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